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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,807	08/04/2003	Ervin Wagner	8894.01-1	7226

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EXAMINER

CHIU, RALEIGH W

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/633,807

Applicant(s)

WAGNER, ERVIN

Examiner

Raleigh Chiu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 5-9 and 21-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 10-17 is/are rejected.
- 7) ☒ Claim(s) 18-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-4 and 10-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reinprecht (USPN 5,09,620) and applicant's admission of the prior art as set forth in the previous Office action.

Regarding claims 1, 2, 4, 10-12 and 14-17, Figure 1 of Reinprecht shows a typical tennis training session with an instructor on one side of the net and the students on the other side. See column 2, lines 41 *et seq.* A typical training session often has the instructor sequentially project a plurality of game balls toward the student. See instant specification, paragraph [0001]. It is noted that Reinprecht teaches the concept of placing targets at specific locations on the tennis court at which the students aim; striking balls to such locations (*i.e.*, the corners as shown in Figure 1 of Reinprecht), are those designed to be shots away or out of reach by an opponent. Also, Reinprecht specifically discusses that it is old and well-known in the tennis teaching art to create difficult patterned drills to mimic match scenarios, and develop

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playing strategies against mimicked match scenarios. See the bridging paragraph between columns 2-3. Moreover, it is old and well-known in the art for team coaches to place people on the court (tennis, basketball, football, etc.) to simulate how a particular point or play is supposed to develop. As Reinprecht introduces the concept of striking particular targets on the court to practice particular shots (down-the-line, crosscourt, etc.) in order to mimic certain or particular match scenarios, it would have been obvious to one of ordinary skill in the art to place a person at a location where a typical player/opponent might stand during that shot to better simulate actual game situations. The persons placed at these locations can be considered simulated opponents for practice purposes. Because tennis play is naturally dynamic, the simulated opponents would naturally and sequentially appear at different locations depending on (1) the direction of the particular ball projected by the instructor and (2) the particular strategy attempted to be employed or scenario attempted to be portrayed. Also, the presence of the Reinprecht targets is considered to naturally train the player to hit the ball away from an opponent, *i.e.*, it is a much more common tennis strategy to hit the ball away from, rather than to, an opponent. The test for obviousness is not whether the features may be bodily incorporated into the

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structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all the references. Rather, the test is what the combined teaching of the references would have suggested to those of ordinary skill in the art.

With further regard to claims 2 and 14, it would have been naturally obvious for a coach, in placing people on the court, to illustrate a particular concept commensurate to the student's skill level.

Regarding claims 3 and 13, tennis ball machines are old and well-known in the art to sequentially project balls to players.

With further regard to claim 10, by having a coach place people on the court, it is submitted that such would naturally allow the tennis player to train placement and muscle memory.

With further regard to claims 15-17, it is also submitted that the people situated on the court by the coach would naturally correspond to the recited simulated opponents.

Response to Arguments

3. Applicant's arguments filed 20 April 2006 have been fully considered but they are not persuasive.

Applicant's arguments relative to Reinprecht do not appear to be directed to the aspects on which reliance is made.

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Applicant argues that Reinprecht does not disclose or suggest that the target locations are those designed to be shots away or out of reach by an opponent because Reinprecht consistently teaches the use of a plurality of sport court targets for training purposes. However, it is noted here that as a natural consequence of training players to aim at specific targets, hitting such targets would also be known by those of ordinary skill in the tennis art to be indicative of those shots designed to be away from or out of reach by a potential opponent since generally, a tennis player achieves better results when hitting the ball away from, rather than to, his opponent. And, as applicant has acknowledged, it is old and well-known in the art for coaches to place people on the court to simulate how a particular point is supposed to develop. Therefore, by having a coach place people on the court to simulate how a particular point is supposed to develop, combined with the Reinprecht concept of attempting to hit particular targets on the court, and combined with the knowledge that it is advantageous to hit balls at targets or locations that are away from an opponent or out of an opponent's reach in a game of tennis, the claimed method of training a player to strike a tennis ball away from a opponent has been taught. Further, as a consequence of practicing by repeatedly hitting balls at targets, one is

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considered to naturally train both placement and muscle memory since such memory is achieved by the constant repetition of strokes and the player's ability to remember it.

Allowable Subject Matter

4. Claims 18-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raleigh Chiu whose telephone number is (571) 272-4408. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim, can be reached on (571) 272-4463.

The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raleigh W. Chiu
Primary Examiner
Technology Center 3700

RWC:dei:feif

7 July 2006